

B

- 1 -

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	Before the Examiner:
Cheng et al.	:	Baum, Ronald
Serial No.: 09/657,122 ✓	:	Group Art Unit: 2136
Filed: September 7, 2000	:	
Title: VIRTUAL PRIVATE NETWORK	:	IBM Corporation
WITH MULTIPLE TUNNELS	:	Intellectual Property Law Dept.
ASSOCIATED WITH ONE GROUP	:	11400 Burnet Road
NAME	:	Austin, Texas 78758

RESPONSE TO NOTICE OF ALLOWANCE §1.312

Mail Stop Issue Fee
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Dear Sir:

Applicants would like to note that the amendment made to claim 25 by including the phrase "a copy of" after the phrase "wherein said server node has a single" as well as amending the preamble to be "A virtual private network system" instead of "A network system" was not to overcome prior art but to clarify the subject matter and advance prosecution. Hence, the amendments made to claim 25 and the dependent claims (preambles amended to be "The virtual private network system") were not narrowing in scope and therefore no prosecution history estoppel arises from such amendments. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, these amendments were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

Furthermore, Applicants respectfully assert that claims 1, 2, 5-48 and 51-70 are allowable for at least the reasons indicated in Applicants' response (in addition to the Examiner's reasons for allowance) with a mailing date of February 13, 2004.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Applicants

By: 

Robert A. Voigt, Jr.
Reg. No. 47,159
Kelly K. Kordzik
Reg. No. 36,571

P.O. Box 50784
Dallas, Texas 75201
(512) 370-2832

Austin_1 256779v.1